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P700600US-PCT/JG/SAC**REMARKS**

Claim 75-79 are objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 75 and 77-79 have been amended to depend on claim 67.

Claims 49, 50, 52, 53, 55-65, 67 and 69-73 stand rejected under 35 USC §102(b) as being anticipated by Shimdada (U.S. Patent No. 4,162,389). Shimdada does not disclose a method or apparatus for welding overlapping members having a tenacious surface oxide layer. Shimdada teaches a welding apparatus that welds two members 39 together. The two members 39 do not overlap, but are welded to each other at a right angle by a weld 38, as shown in Figures 9, 10 and 11. The members 39 also do not have a tenacious oxide surface layer as recited in the claimed invention. Shimdada only discloses that the members 39 are made of a mild steel or a high tensile steel (column 3, lines 51-65 and column 6, lines 50-52). Shimdada does not disclose that the members 39 have any layer as claimed. The claimed invention is not anticipated, and Applicant respectfully requests that the rejection be withdrawn.

Shimdada also does not disclose a weld pool support as recited in claims 67 and 69-73. In the Figure on page 3 of the Office Action (Figure 11 in Shimdada), the Examiner contends that a weld pool support is located under the line at the bottom of the figure. However, the part below the line is not a weld pool support. The line indicates that only a portion of the member 39 is illustrated in Figure 11; the line does not indicate a surface. Figure 11 is an enlarged view of a portion of Figure 9, and Figure 9 does not illustrate any support member. Shimdada does not disclose a weld pool support member, and the claimed invention is not anticipated.

Claims 49, 52, 53, 55, 56, 59, 62 and 65 stand rejected under 35 USC §102(b) as being anticipated by Takano (U.S. Patent No. 5,256,856). Takano does not disclose overlapping members as claimed. In Takano, as shown in Figure 2, the members are located side by side and do not overlap. Takano teaches a base material 4 and a filler wire 3 that is melted to form a weld metal 7 (weld pool). That is, in Figure 2, the weld metal 7 is the weld pool and is not overlapping members. The base material 4 and the weld metal 7 are not

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overlapping members as claimed. The rejection is improper, and Applicant respectfully requests that the rejection be withdrawn.

Claims 75-77 stand rejected under 35 USC §103(a) as being obvious over Shidada in view of Nobuaki (JP 60015070). Claims 75-77 depend on patentable independent claim 67 and are allowable for the reasons set forth above. Adding Nobuaki to the combination still does not render the claims obvious. Claims 75-77 are not obvious.

Claim 51 stands rejected under 35 USC §103(a) as being obvious over Shidada in view of Saitou (U.S. Patent No. 5,591,359). Claim 51 depends on patentable independent claim 49 and is allowable for the reasons set forth above. Adding Saitou to the combination still does not render the claim obvious. Claim 51 is not obvious.

Claims 54 and 74 stand rejected under 35 USC §103(a) as being obvious over Shidada in view of Kelly (U.S. Patent No. 6,489,584). The present application was filed January 28, 2002 and claims priority to a PCT application filed July 28, 200 and two Great Britain patent applications filed August 6, 1999 and October 15, 1999. Kelly was filed May 8, 2001 and issued on December 3, 2002. Kelly is not prior art over the present application. Therefore, the obviousness rejection is improper. The rejection is improper, and claims 54 and 74 are allowable.

Claim 78 stands rejected under 35 USC §103(a) as being obvious over Shidada in view of Umeno (U.S. Patent No. 5,449,107). Claim 78 depends on patentable independent claim 67 and is allowable for the reasons set forth above. Adding Umeno to the combination still does not render the claim obvious. Claims 78 is not obvious.

Claim 79 stands rejected under 35 USC §103(a) as being obvious over Shidada in view of JP 59212169. Claim 79 depends on patentable independent claim 67 and is allowable for the reasons set forth above. Adding the Japanese Reference to the combination still does not render the claim obvious. Claims 79 is not obvious.

Claims 66 and 81 stand rejected under 35 USC §103(a) as being obvious over Shidada in view of Yoshino (U.S. Patent No. 5,599,469). Claims 66 and 81 depend on patentable independent claims 49 and 67, respectively, and are allowable for the reasons set forth above.

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Adding Yoshino to the combination does not render the claims obvious. Claims 68 and 81 are not obvious.

Claims 49-67 and 69-84 are in condition for allowance. The Commissioner is authorized to charge Deposit Account No. 50-1482, in the name of Carlson, Gaskey & Olds, P.C., \$55.00 for a one-month extension of time. If any additional fees are due, however, the Commissioner is authorized to charge Deposit Account No. 50-1482, in the name of Carlson, Gaskey & Olds, P.C., for any additional fees or credit the account for any overpayment. Therefore, favorable reconsideration and allowance of this application is respectfully requested.

Respectfully submitted,

CARLSON, GASKEY & OLDS, P.C.

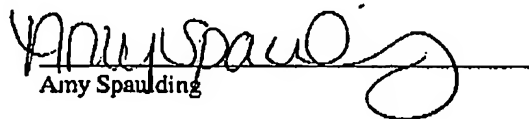


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CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, (703) 872-9306 on July 13, 2004.



Amy Spaulding